AF/1723

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re:	Application of Myron L. Munn	
Serial No.:	10/829,005	
Filed:	April 21, 2004	BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES
Title:	OIL FILTER ADAPTER	
Group No.:	1723	Appeal No. _____

APPELLANT'S APPEAL BRIEF

Commissioner for Patents
Alexandria, VA 22313

Dear Sir:

REAL PARTY IN INTEREST

The Appellant, Myron L. Munn, has not assigned any of his rights to the invention; therefore, the real party in interest is Myron L. Munn.

RELATED APPEALS AND INTERFERENCES

None.

STATUS OF THE CLAIMS

Claims 1-3 and 5 have been cancelled. Claims 4 and 6-8 have received a final rejection and this appeal is an appeal of the final rejection of claims 4 and 6-8.

STATUS OF AMENDMENTS

Appellant filed an Amendment After Final Rejection to replace the word "adapted" with "adapter" in line 1 of claim 4. On March 7, 2007, the Examiner informed Mr. Thomte that the Amendment After Final Rejection would be entered.

SUMMARY OF CLAIMED SUBJECT MATTER

Claim 4 is the only independent claim under appeal. Claim 4 describes an adapter 28 (Figs. 1-8) for attachment to the externally threaded filtered oil tube 12 extending outwardly from an oil filter receptacle 10 of the engine which normally threadably receives the internally threaded filtered oil outlet at one end of a standard oil filter canister 17 with the one end thereof having a canister O-ring or gasket 22 provided thereon. (Page 5, lines 2-12). The standard and replacement oil filter canisters 24 having substantially the same diameter with the replacement oil filter canister having a greater length than the standard oil filter canister 17 to provide a greater filter capacity thereof. (Page 5, lines 11-25; page 6, lines 1-2).

Claim 4 specifically describes a disc-shaped adapter member 28 which has an engine side and a filter side. (Page 6, lines 9-20). Claim 4 specifically describes that the engine side of the disc-shaped adapter 28 has an annular O-ring or gasket groove 34 formed therein. (Page 6, lines 12-13). Claim specifically describes an O-ring or gasket 36 is positioned in the groove 34 of the disc-shaped adapter member 28 which has the same diameter as the standard canister O-ring or gasket. Claim 4 specifically describes that the disc-shaped adapter member 28 has an internally threaded central opening 40 formed therein which extends inwardly from the engine

side thereof which is adapted to threadably receive the externally threaded filtered oil tube 12 of the oil filter receptacle 10. (Page 6, lines 15-25; page 7, lines 1-3). Claim 4 specifically describes that the disc-shaped adapter member 28 has an externally threaded, hollow nipple 50 extending from its filter side at the center thereof which is in communication with the interior of the internally threaded central opening 40 in the disc-shaped adapter member 28. (Page 7, lines 4-7). Claim describes that the threads of the hollow nipple 50 match the threads of the oil outlet 52 of the replacement oil filter canister 24. (Page 6, lines 24, 25; page 7, lines 1, 4-10). Claim 4 further describes that the disc-shaped adapter member 28 has a plurality of spaced-apart unfiltered oil passageways 54 formed therein which extend therethrough from the engine side to the filter side thereof outwardly of the central opening of the disc-shaped adapter member 28. (Page 7, lines 23-25; page 8, lines 1-4).

Claim 4 also describes that the filter side of the disc-shaped adapter member 28 has an annular seat 46 formed thereon which is positioned outwardly of the hollow nipple 50 and the unfiltered oil passageway 54 thereof. (Page 7, lines 4-6). Claim 4 describes that the internally threaded filtered oil outlet 52 of the replacement oil filter canister 24 selectively threadably receives the externally threaded hollow nipple 50 whereby the canister O-ring or gasket 26 of the replacement oil filter canister 24 may be drawn into sealing engagement with the annular seat 46 on the filter side of the disc-shaped adapter member 28. (Page 7, lines 11-25; page 8, lines 1-20).

Claim 6 depends from claim 4 and specifically describes that the threads of the internally threaded central opening 40 of the disc-shaped adapter member 28 are SAE threads and the threads of the hollow nipple 50 are metric threads. (Page 6, lines 24, 25; page 7, lines 9, 10).

Claim 7 depends from claim 4 and describes that the annular seat 46 on the filter side of the disc-shaped adapter member 28 has a width sufficiently large enough to enable replacement oil filter canister O-rings or gaskets of various diameters to be placed into sealing engagement therewith. (Page 8, lines 22-25; page 9, lines 1-8).

Claim 8 is dependent on claim 4 and describes that the disc-shaped adapter member 28 and the hollow nipple 50 are of one-piece construction. (Page 6, lines 6, 7; Fig. 5).

Each of the claims 4, 6, 7 and 8 are believed to be independently patentable and stand by themselves.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether claims 4 and 7 are patentable over Sparling US 5,766,451 pursuant to 35 U.S.C. § 102(b).

It is the Examiner's contention that with respect to claim 4, Sparling teaches an oil filter adapter comprising: a disc-shaped adapter member (10) having an engine side and a filter side with the engine side having an annular O-ring (36) in a groove (38) with the O-ring (36) having the same diameter of a standard canister O-ring. The Examiner believes that the adapter member (10) of Sparling has an

internally threaded central opening (20) formed therein which extends inwardly from the engine side thereof which is adapted to threadably receive an externally threaded filtered oil tube of the oil filter receptacle with the adapter member having an externally threaded, hollow nipple (4) extending from the filter side at the center thereof which is in communication with the interior of the internally threaded central opening in the adapter member. The Examiner further contends that with respect to claim 4, the threads of the hollow nipple match the threads of the oil outlet of the replacement oil filter canister (58) with the adapter member having a plurality of spaced-apart unfiltered oil passageways (17) formed therein which extend therethrough from the engine side to the filter side thereof outwardly of the central opening of the adapter member. The Examiner further contends that the filter side of the adapter member has an annular seat (26) formed thereon which is positioned outwardly of the hollow nipple and the unfiltered oil passageway thereof and that the internally threaded filtered oil outlet of the oil filter canister threadably receives the externally threaded hollow nipple whereby the canister O-ring may be drawn into sealing engagement with the annular seat of the adapter member. (Fig 3).

With respect to claim 7, the Examiner contends that Sparling further teaches that the threads of the internally threaded central opening of the adapter member are different than the threads on the hollow nipple and refers to Col. 7, lines 53-59. The Examiner also believes that the annular seat on the filter side of the adapter member of Sparling has a width sufficiently large enough to enable replacement oil filter

canister O-rings of various diameters to be placed into sealing engagement therewith and refers to Fig. 3.

(B) Whether claim 6 is anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sparling '451.

In paragraph No. 3 of the final rejection, the Examiner rejected claim 7, but it is assumed that "7" was a typographical error and that the rejection should have been directed to claim 6. In the rejection, the Examiner contends that Sparling teaches that the threads of the internally threaded central opening of the Sparling adapter member are different than the threads of the hollow nipple (Col. 7, lines 53-59), but admits that Sparling is silent about the internally threaded opening threads being SAE threads and that the hollow nipple threads are metric threads. The Examiner concluded that having different configurations of a filter and its connections would imply such a configuration as taught by Sparling (Col. 7, lines 53-59) or in the alternative would have been obvious to one of ordinary skill in the art at the time the invention was made because the use of metric and SAE threads are commonplace in engine connections and oil filters.

(C) Whether claim 8 is patentable over Sparling '451 under 35 U.S.C. § 103(a).

The Examiner states that Sparling teaches the adapter member of claim 4, but admits that Sparling does not teach a one-piece construction. The Examiner concluded that it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the adapter member and the hollow nipple a

one-piece construction on the grounds that the use of a one-piece construction ... would be merely a matter of obvious engineering choice and cites In re Larson, 144 USPQ 347, 349 (1965).

ARGUMENT

(A) Whether claims 4 and 7 are patentable over Sparling US 5,766,451 pursuant to 35 U.S.C. § 102(b).

Sparling relates to an inline pressure oil filter adapter which places an anti-siphon or anti-drain back valve into the stream of lubricant pumped to lubricate the engine or mechanical device to keep the lubricant out of the lubrication system and oil filter once the lubrication pump providing the stream of lubricant is turned off. The fluid filter adapter of Sparling does not enable a replacement oil filter canister to be substituted for the standard oil filter canister as required by claims 4 and 7. Claim 4 specifically describes that the replacement oil filter canister has a length greater than the standard oil filter canister and has an O-ring or gasket provided thereon which has a greater diameter than the standard canister O-ring or gasket. It is the annular seat 46 provided at the filter side of the adapter which enables the larger diameter O-ring or gasket of the replacement oil filter to sealably engage the same. As seen in Fig. 3 of Sparling, the O-ring or gasket 36 on the engine side of the adapter has the same diameter as the element 26. Thus, Sparling cannot anticipate claims 4 and 7. Claim 7 depends from claim 4 and describes that the annular seat on the filter side of the disc-shaped adapter member has a width sufficiently large enough to enable replacement oil filter canister O-rings or gaskets of various diameters to be placed

into sealing engagement therewith. There is absolutely no teaching whatsoever in Sparling that the Sparling adapter enables replacement oil filter canister O-rings or gaskets of various diameters to be placed into sealing engagement with the claimed annular seat which is on the filter side of the disc-shaped adapter member.

Accordingly, it is believed that each of claims 4 and 7 are independently patentable and stand by themselves.

(B) Whether claim 6 is anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sparling '451.

Claim 6 depends from claim 4 and specifically describes that the threads of the internally threaded central opening of the disc-shaped adapter member are SAE threads and the threads of the hollow nipple are metric threads. With respect to the Examiner's contention that Sparling teaches the threads of the internally threaded central opening of the adapter member to be different than the threads on the hollow nipple, Appellant submits that there is no suggestion or inherent teaching in Sparling that the threads of the internally threaded opening of the disc-shaped member could be SAE threads and that the threads of the hollow nipple could be metric threads. Accordingly, claim 6 cannot be anticipated. With respect to the Examiner's alternative rejection under 35 U.S.C. § 103(a), there is absolutely no suggestion, teaching or motivation in Sparling to modify Sparling to provide the claimed SAE threads and metric threads. It is quite apparent from the prior art that Appellant is the first person to provide the claimed adapter wherein the threads of the internally threaded central opening of the disc-shaped adapter member are SAE threads and

the threads of the hollow nipple are metric threads. This structure enables the larger capacity replacement oil filter canister, which has internal metric threads, to be utilized with an oil filter receptacle of an automotive engine which has an externally threaded filtered oil tube which has SAE threads. Appellant submits that claim 6 is not anticipated by Sparling nor is it made obvious by Sparling.

(C) Whether claim 8 is patentable over Sparling '451 under 35 U.S.C. § 103(a).

Claim 8 depends from claim 4 and that the disc-shaped adapter member and the hollow nipple are of one-piece construction. Claim 8 is believed to be allowable for the reasons expressed in support of claim 4 and is believed to be independently patentable and stands by itself. The one-piece construction of Appellant's adapter enables the larger replacement oil filter canister to be mounted to the oil filter receptacle of an automotive engine in a very quick and convenient fashion. The fact that Appellant's adapter is of one-piece construction eliminates any possibility of leakage between the nipple and the remaining structure as may be possible in the Sparling structure. Accordingly, it is believed that claim 8 is clearly patentable over Sparling.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the original of APPELLANT'S APPEAL BRIEF for MYRON L. MUNN, Serial No. 10/829,005, was mailed by first class mail, postage prepaid, to the Mail Stop Appeal Briefs-Patent, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 8th day of March, 2007.

DENNIS L. THOMTE

CLAIMS APPENDIX

1. (Cancelled)

2. (Cancelled)

3. (Cancelled)

4. (Appealed) An oil filter adapter for attachment to the externally threaded filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine which normally threadably receives the internally threaded filtered oil outlet at one end of a standard oil filter canister with the one end thereof having a canister O-ring or gasket provided thereon, the adapter enabling a replacement oil filter canister to be substituted for the standard oil filter canister with one end of the replacement oil filter canister having a canister O-ring or gasket provided thereon outwardly of an internally threaded filtered oil outlet, the standard and replacement oil filter canisters having substantially the same diameter with the replacement oil filter canister having a greater length than the standard oil filter canister to provide a greater filter capacity thereof, the replacement canister O-ring or gasket having a greater diameter than the standard canister O-ring or gasket, the oil filter adapter comprising:

a disc-shaped adapter member having an engine side and a filter side;

said engine side of said disc-shaped adapter member having an annular O-ring or gasket groove formed therein;

an O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member which is adapted to sealably engage the oil filter receptacle;

said O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member having the same diameter as said standard canister O-ring or gasket;

said disc-shaped adapter member having an internally threaded central opening formed therein which extends inwardly from said engine side thereof which is adapted to threadably receive the externally threaded filtered oil tube of the oil filter receptacle;

said disc-shaped adapter member having an externally threaded, hollow nipple extending from its said filter side at the center thereof which is in communication with the interior of said internally threaded central opening in said disc-shaped adapter member;

the threads of said hollow nipple matching the threads of the oil outlet of the replacement oil filter canister;

said disc-shaped adapter member having a plurality of spaced-apart unfiltered oil passageways formed therein which extend therethrough from said engine side to said filter side thereof outwardly of said central opening of said disc-shaped adapter member;

said filter side of said disc-shaped adapter member having an annular seat formed thereon which is positioned outwardly of said hollow nipple and said unfiltered oil passageway thereof;

the internally threaded filtered oil outlet of the replacement oil filter canister selectively threadably receiving said externally threaded hollow nipple

whereby the canister O-ring or gasket of the replacement oil filter canister may be drawn into sealing engagement with said annular seat on said filter side of said disc-shaped adapter member.

5. (Cancelled)

6. (Appealed) The oil filter adapter of claim 4 wherein the threads of said internally threaded central opening of said disc-shaped adapter member are SAE threads and the threads of said hollow nipple are metric threads.

7. (Appealed) The oil filter adapter of claim 4 wherein said annular seat on said filter side of said disc-shaped adapter member has a width sufficiently large enough to enable replacement oil filter canister O-rings or gaskets of various diameters to be placed into sealing engagement therewith.

8. (Appealed) The oil filter adapter of claim 4 wherein said disc-shaped adapter member and said hollow nipple are of one-piece construction.

EVIDENCE APPENDIX

None.

RELATED PROCEEDINGS APPENDIX

None.